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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,532	08/19/2003	Alex Lindsay-Scott	D/A2477	4253
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PATS, JUSTIN				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/643,532

**Applicant(s)**

LINDSAY-SCOTT ET AL.

**Examiner**

JUSTIN M. PATS

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. The following is a Final office action. In response to Examiner's communication of 10/7/08, Applicant, on 1/7/09, amended claim 1. Claims 1-3, 5-13 are pending in this application and have been rejected below.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1–3, 5–13 are directed to non-statutory subject matter because they fail to meet the legal requirements of a 'process'. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: a process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For the purposes of § 101, federal case precedent has given a "process" a specialized, and limited meaning. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). A § 101 process must either (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing. Specifically, as illustrated by *Benson*, the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Furthermore, the involvement of a particular machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101. Here, claims 1–3, 5–13 merely identify, analyze, collect, record, measure, analyze, and modify data. These process steps are not tied to a

particular machine, nor is there a transformation of the data pertinent to the claim. First, although there is a nexus to a workbook within the claim, this workbook is ostensibly merely software-based and not some kind of physical structure. Second, Applicant's amendment to include the phrase 'computer-implemented' in the preamble is considered a nominal recitation and does not impart a sufficient structural tie. Alternatively, for example, inserting the phrase 'by a processor' after key method steps such as analyzing, measuring, and modifying, would suffice to meet the particular machine prong of the machine-transformation test, assuming support for this feature is evident from Applicant's specification. Thus, as currently claimed, the methods of claims 1-3, 5-13 persist as non statutory processes under 35 U.S.C. § 101.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1–3, 5–13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gjendem, B2E Business to Enterprise, PRICEWATERHOUSECOOPERS, Jan. 22, 2001, pg. 1–38 in view of Kettinger and Teng, *Aligning BPR to Strategy: a Framework for Analysis*, Long Range Planning, Vol. 31, No. 1, 1998, pg. 93–107 [hereinafter Kettinger1] further in view of Hajmiragha, U.S. Pat. No. 6,289,460.

7. As per claim 1, Gjendem teaches a computer implemented method for assessing content management within an organization (pg. 9–10, 12, and 26, discussing use of portals to collect, search, send, and report information, pg. 29, showing electronic document housings), comprising: identifying business critical information across processes and groups within the organization, wherein business critical information comprises information stored in the form of web content, electronic documents, paper documents and unrecorded information (pg. 8, listing different types of information such as sales/marketing, research and development, and accounting, being stored in a log archive; *see also* pg. 8, illustrating web content; pg. 29, illustrating paper files and electronic documents; unrecorded information such as Staff knowledge); identifying transactions between users within the organization which are associated with the business critical information (pg. 18, Information value chain, data; transaction records); identifying major value chain processes within the organization for managing the business critical information and their associated transactions (pg. 22, Design & Pilot, knowledge-enabled processes; pg. 23, Performance improvements, structuring information processes; pg. 27, Knowledge-Enabled processes; pg. 29, processes as part of the maturity profile; pg. 32, Site map, Processes); analyzing the role and flow of the business critical information and their associated transactions within the major value chain processes across organizational groups within the organization to develop a set of modifications to the major value chain processes for achieving an optimized flow (pg. 22, Design & Pilot, Organizational roles and incentives; pg. 25, D. Perform Content Analysis, Identify Key roles; Analyze Technical Infrastructure; pg. 22, Envision Knowledge Strategy, Develop high-level design of knowledge domains, flows and infrastructure, pg. 25, Inputs, Process knowledge mapping, Content/knowledge flows from

Knowledge Map; Outputs, Current state of knowledge flow in the business, View of business process enhanced by knowledge flow; pg. 30, Knowledge Flow); measuring the flow of the business critical information and their associated transactions through the major value chain processes across the organizational groups within the organization to determine a baseline flow for the business critical information (*id.*, Outputs, Baseline to measure progress); and modifying the major value chain processes in accordance with the set of developed modifications and measuring the flow of the business critical information and their associated transactions through the modified major value chain processes (pg. 25, E. Deploy Pilot, Knowledge-enabled process implementation, Measure Impact). Gjenden teaches (1) the positive evolution of an organization via effective knowledge management as well as a bullet point indicating best practice (Gjenden, pg. 22), and (2) a diagnostic tool showing where the company current maturity level, their target goal of where they want 'to be', and a best practices level (pg. 28, 29), but does not explicitly teach modification occurring until the optimal flow has been achieved. Kettinger1 teaches this in the analogous art of business process improvement and reengineering (Kettinger1, pg. 97, "It may be necessary to continually fine tune certain aspects of the new process until acceptable performance gains are achieved."). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Gjenden to include the teaching of Kettinger1 because an optimal flow yields optimal productivity which increases a company's profits.

Gjenden in view of Kettinger1 does not explicitly disclose the identification of digital media. However, Official Notice is taken that the identification and use of digital media was old and well known in the art at the time of the invention. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Gjenden in view of Kettinger1 to

include the teaching of Official Notice because putting media in digital form frees up storage and server resources, lowers costs, and enhances data transmission rates.

Gjenden also teaches the means for executing the method steps of claim 1 (Gjenden, pg. 9, discussing the portal's collecting capabilities; pg. 12, discussing the portal's integration capabilities; pg. 13, discussing the portal as the primary vehicle by which people do their work; pg. 23, System integration; pg. 27, Technology, Leverage tools; pg. 29, Diagnostic tool).

Finally, Gjenden in view of Kettinger1 does not explicitly teach using a customizable and collection-enabled workbook with an ordered set of templates specifically designed for gathering and performing the identification steps of claim 1. Hajmiragha, in the analogous art of document management systems, teaches this (col. 5, lines 21–38, discussing customized sets of community, company, and user level templates; Fig. 2, ref. 104, correspondence manager).

It would have been obvious to one of ordinary skill in the art to modify Gjenden in view of Kettinger1 to include the teaching of Hajmiragha because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hajmiragha does not explicitly separating the templates and associate known functionality into three workbooks as claimed by Applicant. However, absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or more workbooks ( $W_1, W_2, W_3, \dots W_N$ ) which comprise on or more functionality ( $F_1, F_2, F_3, \dots F_N$ ) and add, subtract, or substitute a number of workbooks ( $X$ ) to comprise all or part of the same functionality by allocating the functionality between the various workbooks (i.e.  $W_1$  and  $W_{N+1}$

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comprise  $F_1$ ;  $W_2$  and  $W_{N+2}$  comprise  $F_2$ ;  $W_3$  and  $W_{N+3}$  comprise  $F_3$ ; ... while  $W_N$  and  $W_{N+X}$  comprise  $F_N$ ). In other words, a modification to the number or labeling of workbooks (e.g. having two particular workbooks comprise functionality previously comprised within one more other denoted workbooks) is analogous to making functions, structures, or actions separable. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable. See MPEP §2144.04 V. C. and In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). It is desirable to allocate the functionality to various workbooks, to promote better organization of data and emphasize the importance of particular components of the system, providing a more focused method that aids users in pinpointing specific areas upon which improvement can be made.

Finally, regarding the collecting and recording of *unrecorded* information, Gjendem teaches this concept via its collection of tacit, less structured information in order to produce knowledge (Gjendem, pg. 18, "Tacit, Less structured", pg. 19, "There are two types of knowledge: tacit and explicit").

8. As per claim 2, Gjenden teaches recording the identified unrecorded information (pg. 20, Generate Knowledge, Capture arrow).

9. As per claim 3, Gjenden teaches wherein the step of analyzing the role and flow of the business critical information and their associated transactions includes pinpointing problems in

which business critical information, knowledge and processes combine to affect key business performance indicators (pg. 29, Maturity profile, showing combined performance gap view from as-is to best practice applied to different information sources; pg. 27, the information and knowledge environment showing the existent synergy between people, content, processes, and technology; pg. 31, "How did you solve that problem"; "Effective knowledge programs identify and leverage know-how embedded in work with a focus on how it will be applied"; "Drives performance support and process innovation").

10. As per claim 5, Gjenden teaches wherein the step of analyzing the role and flow of the business critical information and their associated transactions includes developing a set of metrics for measuring the flow of the business critical information and their associated transactions through the major value chain processes across the organizational groups within the organization (Gjenden, pg. 24, KM measurements, KM benchmarking survey, pg. 25, E. Deploy Pilot, "measure impact"; Outputs, "baseline to measure progress"; *see also* pg. 28–29, Maturity Profile, showing proposed progress of organization based on performance level metrics).

11. As per claim 6, Gjenden teaches defining a business service within the organization which uses business critical information in a defined way (Gjenden, pg. 22, I. Envision Knowledge Strategy, Determine priorities and develop B2E strategy, Develop high-level design of knowledge domains, flows and infrastructure, Develop implementation roadmap, info structure; Design & Pilot, Develop detailed design), wherein each workbook may be further defined for each business service (*see discussion supra* ¶ 7).

12. As per claim 7, Gjenden does not explicitly teach wherein defining the business service step comprises defining an executive assessment for identifying areas within the organization where solving document, content and knowledge issues could provide major benefits. Kettinger1 teaches this (Kettinger1, pg. 97, Securing management commitment). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Gjenden to include the teaching of Kettinger1 because an organization is more productive and efficient when all its members, especially its senior management who make the most important decisions, are cognizant of areas in which an organization can improve and the proposed methods for improvement.

13. As per claim 8, Gjenden teaches wherein the defining the business service step comprises defining a content strategy for identifying and managing content-related initiatives across the organization (*see discussion supra ¶ 11*).

14. As per claim 9, Gjenden teaches wherein the defining the business service step comprises defining a knowledge and work practice assessment for identifying critical and competitive factors within the organization (*id.*; *see also* pg. 19, defining different types of knowledge and assessing their extractable nature within an overall organization).

15. As per claim 10, Gjenden does not explicitly teach wherein the defining the business service step comprises defining a business case for developing a cost-benefit justification of a

proposed content improvement initiative. Kettinger1 teaches this (Kettinger1, pg. 97, Phase 7: Continuous Improvement, Tasks, Assess Cost/Benefit/Risks). It would have been obvious to one having ordinary skill in the art to modify Gjenden to include the teaching of Kettinger1 because cost/benefit analyses give organizations critical insight, enabling them to avoid making poor decisions such as embarking on an initiative that will likely result in a loss rather than a profit.

16. As per claim 11, Gjenden does not explicitly teach wherein the defining the business service step comprises defining a requirements analysis and specification for process innovation for the organization. Kettinger1 teaches this (pg. 96, Organize re-generation team, determine re-generation team skill requirements, Set Performance goals of a “re-designed” process, “Determine External Process Customer Requirements”, Uncover Pathologies, “Detail Internal Customers Process Requirements”; Design IT Architecture, Information Systems Requirements Analysis and Design; Construct Information Systems, Prepare IT Specification; pg. 104, Prototyping the Holistic Process; pg. 104, Developing and Deploying IT, “Detailed analysis specifications are developed”). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Gjenden to include the teaching of Kettinger1 because requirements analysis and specification makes an organization better prepared and more knowledge, and therefore better able to anticipate and comprehend what will be necessary to effect positive organizational change.

17. Claim 12 recites limitations that stand rejected via the art citations and rationale applied to claim 11 as discussed above.

18. As per claim 13, Gjenden teaches wherein the defining the business service step comprises defining two or more of the following for the business: a content strategy, a knowledge and work practice assessment, a business case, a requirements analysis and specification for process innovation and a requirements analysis and specification for solution development (Gjenden, pg. 22, I. Envision Knowledge Strategy, Determine priorities and develop B2E strategy, Develop high-level design of knowledge domains, flows and infrastructure, Develop implementation roadmap, info structure; Design & Pilot, Develop detailed design; pg. 19, defining different types of knowledge and assessing their extractable nature within an overall organization).

***Response to Arguments***

19. Applicant's arguments filed 1/7/09 have been fully considered but they are not persuasive.

20. Applicant argues that its most recent amendments overcome the rejection under 35 U.S.C. 101. Applicant's Remarks, 1/7/09, pg. 5. In response, Examiner respectfully disagrees. Inserting the phrase 'computer implemented' in the preamble amounts to a nominal recitation and does not overcome the rejection under 35 U.S.C. 101 for the reasons discussed above (*see* discussion *supra* ¶ 3).

21. Applicant argues that the cited prior art does not teach or suggest the newly added limitations, notably—for *collecting and recording unrecorded business critical information*. Applicant's Remarks, 1/7/09, pg. 6–7. In response, Examiner respectfully disagrees. Gjendem teaches this concept via its collection and recordation of tacit knowledge as discussed above (*see* discussion *supra* ¶ 7).

***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on Monday through Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/  
Examiner, Art Unit 3623

/Beth V. Boswell/  
Supervisory Patent Examiner, Art Unit 3623